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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91263510
Party	Plaintiff Traxxas, L.P.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TRAXXAS, L.P.	§	Opposition No.: 91263510
	§	
Opposer	§	
	§	
v.	§	
	§	
Mattel, Inc.	§	
	§	
Applicant	§	Application No.: 88583445
	§	Mark: MIGHTY MAX

**OPPOSER TRAXXAS, L.P.’S OPPOSITION
TO APPLICANT’S MOTION FOR LEAVE**

Opposer Traxxas, L.P. (“Traxxas”) opposes Applicant Mattel, Inc.’s (“Applicant”) motion for leave to amend (“Applicant’s Motion for Leave”). Applicant’s Motion for Leave should be denied because the motion is untimely and prejudicial to Opposer at this stage of the proceeding.

On September 22, 2020, Applicant filed its Answer to Opposer’s First Amended Notice of Opposition. On March 24, 2021, more than six (6) months later, Applicant sought leave from the Board to amend its Answer to add the affirmative defense of laches. In connection with Applicant’s Motion for Leave, Applicant provides no explanation as to why it failed to assert the affirmative defense of laches in its original Answer, or why it waited six (6) months to seek leave to amend. At this stage of the proceeding, Applicant’s Motion for Leave is also untimely because both parties are well into their investigation of facts and evaluation of their respective claims and defenses, as well as the discovery schedule.

Pursuant to TBMP § 507.02(a), the timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely. *International Finance Company v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 1604 (TTAB 2002).

In *Media Online Inc. v. El Clasificado Inc.*, the Board denied the petitioner's motion for leave to amend as being untimely when the petitioner waited over ***seven months after its original petition was filed*** (like Applicant's Answer) to seek leave to amend its pleading and add two new claims (like Applicant's new affirmative defense). Specifically, the Board held that the petitioner unduly delayed in filing its motion for leave when its new claims were ***based on facts within petitioner's knowledge at the time the petition to cancel was filed***. *Media Online Inc. v. El Clasificado Inc.*, 88 U.S.P.Q.2d 1285, 1286 (TTAB 2008) (citing *Trek Bicycle Corporation v. StyleTrek Limited*, 64 U.S.P.Q.2d 1540 (TTAB 2001) (motion for leave to amend filed prior to close of discovery denied when based on facts known prior to the start of the case and no explanation for delay)). Furthermore, the Board in *Media Online Inc.* found that the respondent in the case would also suffer prejudice if the petitioner was permitted to add its claims since the petitioner did not claim that it learned of its newly asserted claims through discovery or was otherwise unable to learn about its new claims prior to or shortly after filing its first complaint. *Id.* at 1287.

Just like the petitioner in the Board's *Media Online Inc.* decision, Applicant in this case has also unduly delayed in filing its motion for leave to add pleadings that could and should have been filed with its original Answer. The laches defense Applicant is attempting to add - six (6)

months later - is also completely based on facts within Applicant's knowledge at the time Applicant's original Answer was filed. Specifically, in support of its laches defense, Applicant relies on (1) Applicant's Reg. No. 3,773,522 for the MIGHTY MAX mark, cancelled on November 11, 2016 and (2) Applicant's Ser. No. 86/831,781 for the MIGHTY MAX mark, abandoned on October 7, 2019.

Indeed, Applicant also does not and cannot claim that it learned of this newly asserted defense through discovery (Applicant's Motion for Leave was filed before Opposer's discovery responses were due)¹ or was otherwise unable to learn about this new defense prior to or shortly after filing its original Answer (Applicant's proposed affirmative defense is based on its own trademark registration and application). Applicant therefore had ample time to and should have filed its motion for leave to amend its pleading at an earlier stage in this proceeding – if not at the very outset of this proceeding.

Moreover, in the October 27, 2020 Board order granting Opposer's Motion to Strike Applicant's First Affirmative Defense of priority (Dkt. No. 11), the Board held that in the absence of a counterclaim by Applicant to cancel the incontestable registrations pleaded by Opposer, priority is not at issue as to the marks and goods covered by Opposer's registrations, and Applicant's allegations it was the first to use its mark are irrelevant. Inasmuch as Applicant has not filed a counterclaim against Opposer's pleaded registration since its priority affirmative

¹ Applicant's only discovery requests were served on February 25, 2021 and were not first due until March 29, 2021 (Monday following response deadline falling on a weekend). Opposer had not responded to any of the discovery requests when Applicant's Motion for Leave was filed on March 24, 2021. Therefore, no new information provided by Opposer in discovery could explain why Applicant has delayed seeking to plead this new affirmative defense. Copies of the Certificates of Service for Applicant's discovery requests verifying their service dates are attached as Exhibit A.

defense was stricken, Applicant's prior use, continuous use, *bona fide* intent to use², and trademark abandonment³ of the MIGHTY MAX mark have not been relevant issues in the proceeding and therefore have not been investigated fully by Opposer.

Granting Applicant's Motion for Leave now, which is based on an entirely new affirmative defense that – at minimum – reintroduces the issue of **(1) Applicant's** alleged prior use of the MIGHTY MAX mark and adds the issues of continuous use, *bona fide* intent to use, and trademark abandonment of **(2) Applicant's** alleged MIGHTY MAX mark, **(3) Applicant's** abandoned trademark application, and **(4) Applicant's** cancelled trademark registration. As well, **(5) Applicant's** alleged “irreparable harm” resulting from the alleged delay will be put in issue and require further discovery. Consequently, *no less than five (5) new issues, fronts for dispute, and areas requiring discovery* will be introduced into this proceeding, with only approximately two (2) months presently remaining in the discovery period, unreasonably burdening and prejudicing Opposer.

For at least the reasons discussed above and any other the Board deems appropriate, Opposer respectfully request that Applicant's Motion for Leave to amend be denied as being untimely, lacking any explanation, and as causing great prejudice to Opposer if granted.

² Applicant's abandoned Application Serial No. 86/831,781 was filed on **November 25, 2015**, based on an alleged intent to use the MIGHTY MAX mark. The application became abandoned on **October 7, 2019**, after the 5th extension of time to file a Statement of Use expired, over thirty-six (36) months after a Notice of Allowance had issued for the application, and *almost four (4) years* after the application was filed. Whether Mattel had a *bona fide* intent to use the mark at the time of filing and pendency of the application will be a new issue requiring discovery relating at least to the “unreasonable delay” and “irreparable harm” elements of the newly proposed laches defense.

³ Cessation of use and abandonment of the MIGHTY MAX mark prior to and after the cancellation of Reg. No. 3,773,522 of the MIGHTY MAX mark (for failure to file a Section 8 declaration) asserted in the newly proposed laches defense will be new issues requiring discovery relating at least to the “unreasonable delay” and “irreparable harm” elements of the defense.

/s/ Gregory W. Carr
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CERTIFICATE OF SERVICE

I hereby declare under penalty of perjury that **on April 23 2021** a true copy of the foregoing OPPOSER TRAXXAS, L.P.'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE was served **via email** on **Jill M. Pietrini** at Sheppard Mullin Richter & Hampton LLP, 1901 Avenue of the Stars, Suite 1600, Los Angeles, CA 90067, attorney of record for Applicant, sent to the addresses noted below:

trademarkscc@sheppardmullin.com;

jpietrini@sheppardmullin.com;

rlhudson@sheppardmullin.com;

PBost@SheppardMullin.com; and

MDaner@SheppardMullin.com

/s/ Gregory W. Carr
Gregory W. Carr
Attorney for Opposer

EXHIBIT A

REQUEST FOR ADMISSION NO. 61:

Admit that Opposer did not petition to cancel Mattel's registration of MIDNIGHT
ATTACK MAX, Reg. No. 3,289,466.

REQUEST FOR ADMISSION NO. 62:

Admit that all of Opposer's vehicle products are radio-controlled.

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

Dated: February 25, 2021

By /s/Paul A. Bost

Jill M. Pietrini

Paul A. Bost

Attorneys for Applicant

MATTEL, INC.

CERTIFICATE OF SERVICE

I hereby certify that **APPLICANT MATTEL, INC.'S FIRST SET OF REQUESTS FOR ADMISSION TO OPPOSER TRAXXAS, L.P.** is being emailed to gcarr@carrip.com and trademarks@carrip.com on this 25th day of February, 2021.

/s/Brenda Smith

Brenda Smith

SMRH:4842-8837-9351.2

REQUEST FOR PRODUCTION NO. 38:

All documents reflecting any statements made by persons other than Opposer that Opposer's radio-controlled model vehicles offered under the MAXX Marks are not toys or not intended for children.

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

Dated: February 25, 2021

By /s/Paul A. Bost

Jill M. Pietrini

Paul A. Bost

Attorneys for Applicant

MATTEL, INC.

CERTIFICATE OF SERVICE

I hereby certify that **APPLICANT MATTEL, INC.'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO OPPOSER TRAXXAS, L.P.** is being emailed to gcarr@carrip.com and trademarks@carrip.com on this 25th day of February, 2021.

/s/Brenda Smith

Brenda Smith

SMRH:4816-1195-4391.2

CERTIFICATE OF SERVICE

I hereby certify that **APPLICANT MATTEL, INC.'S FIRST SET OF INTERROGATORIES TO OPPOSER TRAXXAS, L.P.** is being emailed to gcarr@carrip.com and trademarks@carrip.com on this 25th day of February, 2021.

/s/Brenda Smith

Brenda Smith

SMRH:4837-4554-3383.2